

SUPPORT FOR THE AMENDMENTS

Claim 1 has been amended.

Claims 2, 4, 7-9, 11-14, 16, and 18-20 have been canceled.

Support for the amendment of Claim 1 is provided by page 10, line 21 to page 12, line 15 of the specification and Examples 6-8.

No new matter has been entered by the present amendment.

REMARKS

Claims 1, 3, 5, 6, 10, 15, and 17 are pending in the present application.

The rejections of: (a) Claims 1-5 and 7-13 under 35 U.S.C. §103(a) over Kawai et al in view of Goto et al and (b) Claims 6 and 14-20 under 35 U.S.C. §103(a) over Kawai et al in view of Goto et al and Koike et al are respectfully traversed.

In the outstanding Office Action, the Examiner has maintained that the claimed invention is obvious over the combined disclosures of Kawai et al and Goto et al, with or without Koike et al. In fact, the rejections set forth on pages 3-5 of the Office Action are verbatim recitations from the previous Office Action with the sole exception of updating the rejection to reflect the amended ranges of Claim 1.

The clearest, if not most significant, difference between the claimed invention and the cited art is that neither Kawai et al nor Goto et al disclose the weight ratio of antioxidant relative to the net weight of yolk in the enzyme-treated yolk. The Examiner contends that although these reference are individually silent with respect to this ratio, this argument is of no merit as it merely addresses the references individually. Applicants ask, if the references are individually silent with respect to a limitation, how could it be possible that the combination of references suggests that which they do not appreciate?

The Examiner further contends that if the artisan were to add the amount of antioxidant disclosed by Goto et al into the oil-in-water composition disclosed by Kawai et al, then the combination of references would provide motivation to use an overlapping range of the weight ratio of antioxidant relative to the net weight of yolk in the enzyme-treated yolk (note, using the Examiner's calculation addition of 428.5 ppm to 2000 ppm corresponds to a weight percentage of 0.4 to 1.9). However, this is not a relevant comparison and is an unfair treatment of the cited art.

Applicants again submit that the claimed invention would not be obvious in view of the combined disclosures of Kawai et al and Goto et al and that the resulting benefits would not have been expected. To this end, Applicants again refer to the background of the invention bridging pages 1-2 of the specification, from which it is clear that the present invention seeks to solve problems in Kawai et al, for example, which may appear to have excellent outward appearance and physical properties, but has inconsistent taste profiles upon aging. This problem is not disclosed, suggest, or even apparent from the disclosure of Kawai et al. Indeed, at page 2, last two lines, Kawai et al state that their composition have “excellent taste... properties”. Goto et al does not disclose an embodiment having enzyme-treated yolk. As such, this reference does not recognize or even relate to the problems in taste stability in the compositions of Kawai et al.

Applicants previously argued based on *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 43 S.Ct. 322, 67 L.Ed. 523 (1923) that the discovery of a problem or a cause of a problem can lend patentability to an invention. The Examiner disregarded this argument alleging, in part, that *Eibel Process Co.* is distinct from the issue at hand because we failed “to explain how the alteration of a Fourdrinier machine in a way that the prior art had not taught, i.e. change to the thickness of a wire, applies to this situation.” This allegation by the Examiner is clearly erroneous as the factually underpinnings of *Eibel Process Co.* need not be identical to the case at hand for the holding to be relevant.

Indeed, as in *Eibel Process Co.*, in the case at hand the cited art fails to appreciate the problem that pervades their disclosure. In other words, neither Kawai et al nor Goto et al appreciate the problems associated with taste stability. The Supreme Court took up this issue, even if the facts (i.e., alteration of a Fourdrinier machine) are different, holding that the discovery of a problem or a cause of a problem can lend patentability to an invention. The discovery of a problem is often the key to making a patentable invention. Thus, the

patentability of an invention under 35 U.S.C. §103 must be evaluated against the background of the highly developed and specific art to which it relates, and this background includes an understanding of those unsolved problems persisting in the art solved by the invention. *See, Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 43 S.Ct. 322, 67 L.Ed. 523 (1923).

The Examiner further alleges “the properties of the antioxidant, i.e. change in taste profile, cannot patentably distinguish the claimed invention from the prior art because a chemical composition and its properties are inseparable.” Again, this allegation by the Examiner misses the mark. The following holding is what the Examiner references from MPEP 2112.01(II): “Products of identical chemical composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) In the case at hand, the claims are not drawn to “products of identical chemical composition” as neither Kawai et al nor Goto et al disclose a composition of the claimed composition. It is only when the present application is used a guidepost that the claimed composition is arrived at. Further, there is nothing in Kawai et al and Goto et al to suggest what would happen when an antioxidant is added to the claimed composition at the concentrations required.

Yet another allegation by the Examiner is that “the mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention.” Applicants also disagree with this allegation as the claimed invention was not “otherwise known” and the result of adding the antioxidant to the claimed composition in the required concentrations was not inherently achieved in the cited art (i.e., Goto et al).

Moreover, Applicants disagree with the treatment of the references by the Examiner. It is not proper to selectively pick-and-choose random examples to insert an additional ingredient (i.e., antioxidant) in a specific disconnected concentration where neither reference provides any basis to disclose or suggest the amount of the antioxidant relative to the net weight of yolk in the enzyme-treated yolk. It is disclosed in Goto et al, column 4, lines 65-67, that an antioxidant is preferably added to the oil and fat composition of the invention disclosed therein in an amount of 50 to 2,000 ppm. However, this disclosure has no relation to a composition containing an enzyme-treated yolk treated with one or more enzymes selected from the group consisting of esterase, lipase and phospholipase as presently claimed.

Nonetheless, solely to expedite examination, Applicants have amended the claims to require the presence of at least one of 3 emulsifiers that have an HLB value of less than 10 where the emulsifier is present in a specific amount.

With respect to the amended claims, Applicants submit that the foregoing arguments apply and further submit that the claimed invention is an oil-in-water emulsified composition. It is known to the skilled artisan to use an emulsifier having a high HLB value for an oil-in-water emulsified composition. It is also known to the skilled artisan to use an emulsifier having a low HLB value for a water-in-oil emulsion.

Thus, the invention as presently claimed cuts against the common knowledge proving a emulsifier having a low HLB value of less than 10 in a oil-in-water emulsified composition to obtain an unexpected improvement in full-bodied taste and a mild flavor after aging. This unexpected effect is clearly illustrated by Examples 6-8, which use the three species of emulsifiers defined in Claim 6, in comparison to Example 2 which lacks an emulsifier (see Figure 1).

“Evidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut *prima facie* obviousness.

“Evidence that a compound is unexpectedly superior in one of a spectrum of common properties . . . can be enough to rebut a *prima facie* case of obviousness.” No set number of examples of superiority is required. *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987)” Thus, the experimental data discussed above from the specification clearly illustrates that substantial benefits flowing from the claimed method, which are enough to rebut a *prima facie* case of obviousness.

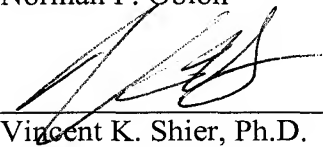
Koike et al is only cited as disclosing the content of trans-unsaturated fatty acids in the fatty acids constituting the diglycerides. This reference does not compensate for the deficiencies in Kawai et al and Goto et al discussed above. As such, the claimed invention would not be obvious in view of the combined disclosures of Koike et al, Kawai et al and Goto et al.

In view of the foregoing, Applicants request withdrawal of these grounds of rejection.

Applicants submit that the present application is in condition for allowance. Early notification to this effect is respectfully requested.

Respectfully submitted,

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